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EXAMINER

GARCIA, MAURIE E

ART UNIT

PAPER NUMBER

1627

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Please find below and/or attached an Office communication concerning this application or proceeding.

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*B. H.
2/10/02*

File copy

Office Action Summary

Application No.

09/456,429

Applicant(s)

Jl et al

Examiner

Maurie E. Garcia, Ph. D.

Art Unit

1627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Oct 11, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 52-54, 56, 58-63, 65, and 67-73 is/are pending in the application

4a) Of the above, claim(s) 58, 67, and 70-73 is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 52-54, 56, 61-63, and 65 is/are rejected.

7) ☒ Claim(s) 59, 60, 68, and 69 is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10

20) ☐ Other: _____

DETAILED ACTION

1. The Response filed October 11, 2001 (Paper No. 15) is acknowledged. Claims 55, 57, 64 and 66 were cancelled, claims 52, 56, 58, 59, 61, 65 and 67 were amended and claims 69-73 were added. Thus claims 52-54, 56, 58-63, 65 and 67-73 are pending.

Election/Restriction

2. In Paper No. 7, Group I drawn to multibinding compounds and pharmaceutical compositions comprising the compounds (original claims 1-15) was elected with traverse. A species of ligand (diltiazem) and specific multibinding compound (compound 79 in Figure 10) were also elected with traverse. The claims have been substantively amended since this election.

3. The elected species discussed above corresponds to formulas (iv) and (vi) of the now amended claims. Previously examined claims 58 and 67 have been completely rewritten and now do not read on the elected species. Newly added claims 70-73 also do not read on the elected species.

4. Thus, since there is currently no allowable generic claim, claims 58, 67 and 70-73 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to non-elected species. See paragraph 5 below, section highlighted in **bold**.

5. With respect to the species election see MPEP § 803.02 (emphasis added):

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and **claims to the nonelected species held withdrawn from further consideration**. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. *Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final.* Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

6. Additionally, a new art rejection based on a non-elected species is set forth below.

This new rejection is necessitated by amendment (exclusion of species); see paragraph 5 above, section highlighted in *italics*.

7. Therefore, claims 52-54, 56, 59-63, 65, 68 and 69 are currently under examination.

Inventorship

8. In view of the papers filed October 11, 2001, the inventorship in this nonprovisional application has been changed by the deletion of Burton G. Christensen. The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Priority

9. The previous objection to the priority claim is withdrawn in view of applicants amended claim to priority.

Withdrawn Rejections

10. The double patenting rejection over Application No. 09/493,081 is withdrawn in view of the abandonment of said application. The provisional 102(e) rejection over this application is also withdrawn. All of the rejections under 35 USC 112 (first and second paragraphs) are withdrawn in view of applicants claim amendments. The rejections under 35 USC 102 over Branca and 35 USC 103 over Joslyn are also withdrawn in view of applicants claim amendments.

New Rejections
Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

12. Claims 52, 53, 54, 56, 61, 62, 63 and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Gluchowski et al (US 5,767,131).

Gluchowski et al disclose compounds made up two identical diphenyl piperidinyl portions (reading on the claimed ligands of formula (iii)) separated by

a symmetric group. See Example 112 of the patent. Note that a printout of the listing from the Registry database is attached to the patent, for applicant's convenience. The symmetric "inner" portion of the molecules of Gluchowski read on the claimed linkers when X' = a bond; Z = alkyl (CH₂)₃; Y' = HNCO; Z = substituted heterocyclene and Y'' = CONH.

The compounds of the reference are made into pharmaceutical compositions and used for various treatments; see patented claims 4-16.

Status of Claims/Conclusion

13. Claims 59, 60, 68 and 69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the

date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:30 to 7:00 and alternate Fridays.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie E. Garcia, Ph.D.
December 29, 2001


PADMASHRI PONNALURI
PRIMARY EXAMINER